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In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 486

THE HOOVER COMPANY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA

MEMORANDUM FOR THE COMMISSIONER OF PATENTS.

OPINION BELOW

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 140-146) is not yet officially reported.

JURISDICTION

The judgment of the District Court was entered on June 21, 1943 (R. 14). The judgment of the Court of Appeals was entered on July 10, 1944 (R. 147). The petition for a writ of certiorari was filed on September 20, 1944. The

jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the United States District Court for the District of Columbia has jurisdiction under Rev. Stat. 4915 (35 U. S. C. 63) over a suit to compel the Commissioner of Patents to allow certain claims which had been rejected by the Patent Office, where the court, if it reversed the Patent Office, could not then order issuance of a patent, since further proceedings in the Patent Office would still be required.

STATUTES AND REGULATION INVOLVED

The relevant portions of the statutes and regulation involved are set forth in the Appendix, pp. 10-14, *infra*.

STATEMENT

United States Patent No. 2,178,870 was granted to C. C. Coons, petitioner's assignor, on November 7, 1939, covering improvements in a refrigerating system (R. 3-4, 8). On January 10, 1941, he applied for reissuance of the patent, presenting a number of claims copied or substantially copied from several later patents in order to provoke an interference (R. 4-6, 113-115). On March 28, 1941, the Primary Examiner allowed sixteen of the claims as "patentable" and "readable" upon the Coons application, and declared the reissue

application to be in interference with two of the patents (Ullstrand, No. 2,215,674, and Anderson, No. 2,203,074) from which the claims had been taken (R. 113-115). However, the Primary Examiner rejected "as not reading on applicant's disclosure" eight claims taken from the Bergholm patent, No. 2,201,362 granted May 21, 1940 (R. 117-128).

Four of these rejected claims were appealed to the Board of Appeals, which affirmed the Primary Examiner (R. 129-133). Thereafter, petitioner as assignee brought suit against the Commissioner of Patents under Section 4915 of the Revised Statutes (35 U. S. C. 63) in the United States District Court for the District of Columbia, to direct the Commissioner to allow the four rejected claims for purposes of an interference proceeding (R. 3-7). After receiving in evidence the record before the Patent Office and additional evidence on behalf of petitioner (R. 24-82), the District Court entered findings of fact and conclusions of law on June 21, 1943, dismissing the complaint on the ground that the appealed claims were not readable on the applicant's disclosure (R. 10-14).

On appeal, the United States Court of Appeals for the District of Columbia, on its own motion, raised the question "whether Section 4915 R. S. confers jurisdiction on the District Court to enter a decree which does not determine the right of the

applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings" (R. 141). Following the submission of memoranda by both parties in support of the jurisdiction of the District Court (R. 141), the court below held that the District Court lacked jurisdiction over the suit and affirmed the judgment dismissing the complaint (R. 147).

DISCUSSION

Revised Statutes 4915 affords a "remedy by bill in equity" to any applicant who has been refused "a patent on application," and provides that "the court having cognizance thereof * * * *may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear.*" (See Appendix, pp. 11-12, *infra*.) The section further provides that

such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and *otherwise complying with the requirements of law.* [Italics supplied.]

The court below held that the first of the above provisions limited the jurisdiction of the district courts to situations in which an adjudication could

be made that the applicant is entitled to a patent. The court then concluded that such an adjudication could not be made here, since a reversal of the Patent Office in the instant case would not entitle petitioner to receive a patent for the claims until priority over Bergholm was determined in the ensuing interference proceedings before the Patent Office—an issue not determinable upon the record before the court. Petitioner argues that the second portion of Section 4915, quoted above shows that the Patent Office need not issue a patent unless, by fulfilling all other requisites of patentability, the applicant is “otherwise complying with the requirements of law”.

The court found reasons of policy to support its conclusion. Noting that the case is “in substance not a suit on the merits but an appeal from the refusal of the Patent Office to take preliminary steps which would lead to interference proceedings,” the court condemned as “contrary to the fundamental concept of equity jurisdiction” the notion “that a court of equity should interfere with the proceedings of an administrative tribunal by a trial de novo at a stage when no decision on the merits can be given” (R. 142). The appropriate remedy, the court indicated, was an appeal to the United States Court of Customs and Patent Appeals under Rev. Stat. 4911, “to correct an administrative ruling of the Patent Office for

error appearing on the Patent Office record" (R. 142).¹

Although there are judicial statements which may be regarded as supporting the decision below (cf. *Hill v. Wooster*, 132 U. S. 693, 698), the practice of the courts has been to the contrary. Prior decisions generally seem to assume that Section 4915 is not limited to cases in which all possible proceedings in the Patent Office have been completed. The courts have repeatedly, and generally without challenge, taken jurisdiction under Rev. Stat. 4915 even where the record revealed that the rejected claims, if allowed, would still have to run the gauntlet of further proceedings in the Patent Office to determine invention or priority. *Pitman v. Coe*, 68 F. (2d) 412 (App. D. C.) (rejection of claims for improper joinder); *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869 (App. D. C.) (rejection on grounds of estoppel); *American Cyanamid Co. v. Coe*, 106 F. (2d) 851 (App. D. C.) (same); *Power Patents Co. v. Coe*, 110 F. (2d) 550 (App. D. C.) (claims rejected because not supported by disclosure in application); *Tully v. Robertson*, 19 F. (2d) 954 (D. Md.) (same); *Monopower Corp. v. Coe*, 33 F.

¹ In this case, petitioner's right to this alternative remedy may be doubtful since petitioner's time for appeal to the United States Court of Customs and Patent Appeals expired before the present suit was instituted. Rev. Stat. 4912; Rule 149, Rules of Practice in the Patent Office (September 1, 1943), p. 41 (R. 131-133). See Appendix, pp. 10-11, 13-14, *infra*.

Supp. 934 (D. C.) (same); *Booth Fisheries Corp. v. Coe*, 114 F. (2d) 462 (App. D. C.), certiorari denied, 311 U. S. 691; (same; need for further proceedings shown in record but not reflected in court's opinion); *Forward Process Co. v. Coe*, 116 F. (2d) 946 (App. D. C.) (same). The courts have likewise entertained suits against the Commissioner under Rev. Stat. 4915 to review rejection of a claim for want of invention (*American Steel and Wire Co. v. Coe*, 105 F. (2d) 17 (App. D. C.); *Abercrombie v. Coe*, 119 F. (2d) 458 (App. D. C.); *General Motors Corp. v. Coe*, 120 F. (2d) (736) (App. D. C.); *Hydraulic Press Corp. v. Coe*, 124 F. (2d) 521 (App. D. C.); *Minnesota Mining & Manufacturing Co. v. Coe*, 125 F. (2d) 198 (App. D. C.)), even though the court's favorable ruling on patentability may be and in some instances has been followed by further proceedings in the Patent Office which deprive the applicant of a patent on the claims which the Court had allowed. *Radtke Patents Corp. v. Coe*, 122 F. (2d) 937 (App. D. C.), certiorari denied, *sub nom American Tri-Ergon Corp. v. Radtke Patents Corp.*, 314 U. S. 695; *Poulsen v. Coe*, 119 F. (2d) 188 (App. D. C.); *Poulsen v. McDowell*, 142 F. (2d) 267 (C. C. P. A.).²

² Apparently the only other instance of the refusal of jurisdiction under Rev. Stat. 4915 is *Shoemaker v. Robertson*, 54 F. (2d) 456 (App. D. C.), which declined to review the re-

The court below recognized (R. 145) that in two earlier cases where the question had not been raised, it had accepted jurisdiction of a Rev. Stat. 4915 proceeding to test the rejection by the Patent Office of claims which, like those here involved, had been copied from other patents or applications to provoke interference proceedings (*International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869; *American Cyanamid Co. v. Coe*, 106 F. (2d) 851). But the court below pointed out that, despite the mandate of the court directing the issuance of a patent to plaintiff, an interference proceeding had been instituted in each case, and it regarded this as an illustration of the inappropriateness of a "declaratory judgment" by a court of equity "on a record which compels the Patent Office to ignore the terms of that judgment" (R. 146).³

refusal of the Patent Office to consider an application not complying with certain formal requisites (the required number of signatures).

³ While statements in the opinion of the court below seem to bar a suit under Rev. Stat. 4915 in any case where subsequent proceedings might be necessary in the Patent Office (see R. 142), the facts in the instant case and other decisions of the court below on the same day suggest that Rev. Stat. 4915 is only inapplicable where the record affirmatively shows that further proceedings in the Patent Office (such as an interference) are necessary. *Line Material Co. v. Coe*, App. D. C. No. 8491, decided July 10, 1944; *The Colgate-Palmolive Peel Co. v. Coe*, App. D. C. No. 8508, decided July 10, 1944. See also *Monsanto Chemical Co. v. Coe*, App. D. C. No. 8472, footnote 2, decided June 26, 1944.

The decision below presents an important jurisdictional question affecting judicial review of Patent Office rulings through a trial *de novo* in a federal district court, as opposed to an appeal to the United States Court of Customs and Patent Appeals under Rev. Stat. 4911 on the record before the Patent Office. It is admittedly inconsistent with past practice under Rev. Stat. 4915. For these reasons, we do not oppose the petition for a writ of certiorari.

Respectfully submitted.

CHARLES FAHY,
Solicitor General.

FRANCIS M. SHEA,
Assistant Attorney General.

DAVID L. KREEGER,
Special Assistant to the Attorney General.

JOSEPH B. GOLDMAN,
Attorney.

OCTOBER 1944.

* If a writ of certiorari should be granted, this Court may desire treatment of the question whether review of intermediate Patent Office rulings or *ex parte* proceedings under 4915 would entail the imposition of non-judicial functions upon the courts of the District of Columbia and thereby preclude ultimate review by this Court. Cf. *Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693, 699; *Frasch v. Moore*, 211 U. S. 1, 9-10.

APPENDIX

I

STATUTES INVOLVED

1. Sections 4911-4915 R. S., as amended (35 U. S. C. 59a-63), provide as follows:

SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. (U. S. C., title 35, sec. 63). If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

SEC. 4912. When an appeal is taken to the United States Court of Customs and

Patent Appeals, the appellant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

SEC. 4913. The court shall, before hearing such appeal, give notice to the commissioner of the time and place of the hearing, and on receiving such notice the commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with

the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

2. The Act of March 3, 1927, as amended (44 Stat. 1394, 35 U. S. C. 72a), provides as follows:

Upon the filing of a bill in the district court of the United States for the District of Columbia wherein remedy is sought under section 63 or section 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 113 of Title 28; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

II

REGULATION INVOLVED

Rule 149 of the Rules of Practice in the United States Patent Office provides, in part, as follows:

149. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within 40 days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing; *Provided*, however, That if a petition for rehearing or

reconsideration is filed within 20 calendar days after said decision, the notice of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing or reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal. * * *

